

**REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed October 17, 2006. Claims 1-5, 11-17 and 20-22 are pending in the application and are rejected. For the reasons discussed below, Applicant respectfully requests reconsideration and favorable action in this case.

**Section 112 Rejections**

The Examiner rejects Claims 1-5, 11-17 and 20-22 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of which applicant regards as the invention. Although Applicant believes the “if” phrase the Examiner refers to is definite, Applicant has amended these claims to explicitly recite what happens when the if statement is “false.” Furthermore, the Applicant has changed the term “interpret” to “process,” as suggested by the Examiner. Thus, reconsideration and favorable action is respectfully requested.

**Section 101 Rejections**

The Examiner rejects Claims 1-5, 11-17 and 20-22 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. The Examiner also rejects Claims 1-5, 11-17 and 20-22 under 35 U.S.C. § 101 because the claimed invention lacks patentable utility.

The patent laws define patentable subject matter as “any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereto.” *See* 35 U.S.C. § 101. When an abstract idea is reduced to a practical application, the abstract idea no longer stands alone if the practical application of the abstract idea produces a useful, concrete, and tangible result. This then satisfies the requirements of 35 U.S.C. § 101. *See In re Alappat*, 33 F.3d 1526, 1544, 31 U.S.P.Q.2d 1545, 1557 (Fed. Cir. 1994); *see also State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 U.S.P.Q.2d 1596, 1601-02 (Fed. Cir. 1998). While an abstract idea by itself may not satisfy the requirements of 35 U.S.C. § 101, an abstract idea when practically applied to produce a useful, concrete, and tangible result satisfies 35 U.S.C. § 101. *See AT&T*

*Corp. v. Excel Comm. Inc.*, 172 F.3d 1352, 1357, 50 U.S.P.Q. 1447, 1452 (Fed. Cir. 1999) (stating that as technology progressed, the CCPA overturned some of the earlier limiting principles regarding 35 U.S.C. § 101 and announced more expansive principles formulated with computer technology in mind); *see also In re Musgrave*, 431 F.2d 882, 167 U.S.P.Q. 280 (CCPA 1970) (cited by the Federal Circuit in *AT&T Corp.*, 172 F.3d at 1356). Thus, producing a useful, concrete, and tangible result is the key to patentability according to *State Street* and other applicable case law.

“Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101.” M.P.E.P. § 2106. Indeed, a method or process remains statutory even if some or all of the steps therein can be performed in the human mind, with the aid of the human mind, or because it may be necessary for one performing the method or process to think. *See In re Musgrave*, 431 F.2d at 893, 167 U.S.P.Q. at 289. As stated by the Federal Circuit in *State Street* and as explicitly confirmed in the M.P.E.P., “[T]ransformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces ‘a useful, concrete, and tangible result’ -- a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.” *State Street*, 149 F.3d at 1373, 47 U.S.P.Q.2d at 1601-02; M.P.E.P. § 2106.

Applicant’s claims are not merely manipulations of abstract ideas. Instead, each of Applicant’s claims clearly recites a useful, concrete, and tangible result, which is all the law requires for a claim to be directed to statutory subject matter, and is therefore directed to patentable subject matter. For example, independent Claim 1 recites “causing any header parameters associated with an upgraded protocol to be removed from said header portion” and “processing said received header according to said legacy protocol.” Thus, modifying headers associated with an upgraded protocol so that they can be interpreted according to a legacy protocol is one practical application of independent Claim 1, the useful, concrete, and tangible result being a modified header that is able to be interpreted

according to the legacy protocol. The other claims of the present application have a similar practical application and utility. Furthermore, Applicant has amended the preambles of the claims in an attempt to further satisfy the Examiner that the claims provide a useful, concrete and tangible result and that the claims have a practical application.

For at least the foregoing reasons, Applicant respectfully submits that 1, 3-5, 11, 13-15, 17, 20, and 22 recite statutory subject matter and claim inventions that have patentable utility. Therefore, Applicant respectfully requests reconsideration and allowance of Claims 1, 3-5, 11, 13-15, 17, 20, and 22.

### **Section 103 Rejections**

The Examiner rejects Claims 1, 2, 4, 5, 11-14, 15, 16 and 20-22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,544,325 issued to Denny ("*Denny*") in view of U.S. Patent No. 6,032,197 issued to Birdwell et al. ("*Birdwell*").

Claim 1 of the present application, as amended, recites the following limitations:

- A method for processing a header portion of a message, comprising:
  - establishing a legacy protocol, wherein said legacy protocol defines at least one legacy parameter for a header portion of a message, and wherein said legacy protocol defines a fixed legacy header length;
  - receiving an inbound message having a header portion;
  - allocating a memory portion from the computer memory, said memory portion having a depth corresponding to said fixed legacy header length;
  - pushing said header portion of said inbound message onto said memory portion thereby forming a received header, wherein the header portion is pushed onto said memory portion such that said header portion is truncated to form the received header when a length of said header portion is greater than said depth of said memory portion corresponding to said fixed legacy header length and wherein said header portion is not truncated when a length of said header portion is not greater than said depth of said memory portion, such truncation causing any header parameters associated with an upgraded protocol to be removed from said header portion; and
  - processing said received header according to said legacy protocol.

Independent Claims 11, 15 and 20 recite similar, although not identical, limitations.

In order to establish a *prima facie* case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations. M.P.E.P. § 2143. In the present case, a *prima facie* case of obviousness cannot be maintained at least because *Denny* and *Birdwell*, whether considered singly, in combination with one another, or in combination with information generally available to those of ordinary skill in the art at the time of the invention, fail to disclose all of the elements of the pending claims. Furthermore, there is no motivation to combine these references in the manner suggested by the Examiner.

For example, neither *Denny* or *Birdwell* disclose “wherein said legacy protocol defines a fixed legacy header length.” The Examiner states that this limitation is disclosed in Figures 3 and 4 of *Denny*. However, *Denny* makes clear that the header (what it refers to as a “prefix”) can be of variable length. *See Col. 5, lines 27-53 and Col. 6, lines 18-20*. Thus, Applicants believe that there is no disclosure of a *fixed* legacy header length.

Furthermore, neither *Denny* or *Birdwell* disclose “allocating a memory portion from the computer memory, said memory portion having a depth corresponding to said fixed legacy header length.” The Examiner states that this limitation is disclosed in Figure 4 (item 70). However, *Denny* specifically discloses that the memory used to store the message is expanded as necessary to accommodate the message size. *See Col. 7, lines 20-33*. For this same reason, *Denny* necessarily does not disclose that a portion of the message is truncated if it is greater than the “depth of the memory portion.” Instead, *Denny* discloses that the memory is increased to accommodate the message. For this reason, there is simply not a motivation to combine a teaching from any reference that discloses truncating a message that is greater than a memory depth with the teachings of *Denny*. This is the opposite of what is done in *Denny*. In any case, *Birdwell* also does not disclose the “truncating” limitation. What is disclosed in the cited passage of *Birdwell* is the compression of a header by

removing fields of the header that are unchanging. This is different than simply truncating whatever portion of a header that does not fit in a memory space.

Finally, in the rejection of Claim 1, the Examiner appears to characterize the coverage of the claim with language that is not recited in the claims. For example, the Examiner indicates on Page 7 of the Office Action that *Denny* discloses “retaining the unrecognized fields associated with the header portion . . .” As another example, the Examiner indicates on Page 8 of the Office Action that *Denny* discloses “dynamically allocating the memory space or stack . . .” Applicant wishes to make clear that neither of these phrases are recited in the claims. Thus, Applicant is unsure why they are included in the Examiner’s argument.

For at least the reasons provided above, Applicant believes that Claim 1 is in condition for allowance. In addition, independent Claims 11, 15 and 20 recite similar, although not identical, limitations to those discussed above. Thus, Applicant believes that these claims are also in condition for allowance. Therefore, Applicant respectfully requests reconsideration and allowance of Claims 1, 11, 15 and 20, as well as the claims that depend from these independent claims.

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The Examiner also rejects Claims 3 and 17 under 35 U.S.C. § 103(a) as being unpatentable over *Denny* in view of *Birdwell* and further in view of U.S. Patent No. 5,206,822 issued to Taylor et al. (“*Taylor*”). Claims 3 and 17 depend from independent Claims 1 and 15, respectively. As discussed above, Applicants believe Claims 1 and 15 are in condition for allowance. Therefore, at least because they depend from an allowable independent claim, Applicant respectfully requests reconsideration and allowance of Claims 3 and 17.

**CONCLUSION**

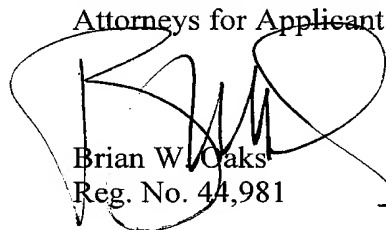
Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all the pending claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicant hereby requests a telephone conference with the Examiner and further request that the Examiner contact the undersigned attorney to schedule the telephone conference.

Although Applicant believes no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.  
Attorneys for Applicant



Brian W. Oaks  
Reg. No. 44,981

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Correspondence Address:

**Customer Number: 05073**